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10/033,883

12/27/2001

Wen-Fa Yao

JCLA3573

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04/20/2005

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EXAMINER

PUNNOOSE, ROY M

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,883

Applicant(s)

YAO ET AL.

Examiner

Roy M. Punnoose

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 0205 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt of applicant's amendments filed on February 03, 2005 is acknowledged.

Applicant's arguments filed February 03, 2005 have been fully considered but they are not persuasive.

2. Applicant's amendment has necessitated the new ground(s) of rejection presented in this Office action, and the amendment to the claims has necessitated the Examiner to make this office action FINAL.

3. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

4. In the papers received on February 03, 2005 the applicant has cancelled claim 2, amended claims 1 and 8 and added new claims 11-17. Currently, claims 1 and 3-17 are pending in the application.

Response to Applicant's Arguments

5. In the Remarks/Arguments section, the applicant contends that Suzuki's photosensor (30b) is not a scanner device. The Examiner disagrees with the applicant's contention because, given the broadest interpretation, a photosensor can be considered as a scanner device as it scans for any incoming light.

6. In response to applicant's argument that Suzuki's apparatus is adopted for measuring a single concentration of a single constituent in the specimen, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the

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prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

7. Furthermore, the applicant contends that Suzuki does not disclose a “driver device.”

The examiner takes Official Notice that it is commonly known to one skilled in the art that a computing unit is used for controlling any desired external peripherals, and that (software and hardware) driver devices are used for driving any external components or devices. For example, Suzuki teaches the use of a LED driver 75 to drive the LED light source (see Figure 2).

Drawings

8. The replacement drawings filed on February 03, 2005 are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The Examiner has requested in the previous office actions that the drawings be corrected. It appears that each time the applicant make amendments to the drawings, new errors are added.

a. The recitation in claim 1 that “a computing unit, coupled to the scanner device ...” is not shown in the drawing. In Figure 1, there is no line that connects the computing device and the scanner device. Therefore, this limitation must be shown or the feature(s) canceled from the claim 1.

b. The recitation in claim 1 that “a controller device, coupled to the scanner device ...” is not shown in the drawing. In Figure 1, there is no line that connects the controller and the scanner devices. Therefore, this limitation must be shown or the feature(s) canceled from the claim 1.

c. The recitation in claim 1 that “a driver device, coupled to the controller device, for receiving the driver signal ...” is incorrectly shown in Figure 1. From the direction of the arrow, it appears that the controller device is receiving the driver signal and not vice versa as claimed in claim 1. Therefore, this limitation must be shown correctly or the feature(s) canceled from the claim 1.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 3-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (US_5,231,576).

11. Claims 1, 7, 8 and 11 are rejected because:

- A. Suzuki et al (Suzuki hereinafter) discloses a scanning analyzer unit for analyzing testing a sample (see col.5, line 29) in a testing support 1 comprising, a scanner device 30b (see col.5, line 39 and Figure 4) for scanning a test support 1 suitable for supporting a reaction of analytes in the sample to achieve a color separation, wherein the scanner device 30b outputs a test signal in response to scanning the testing support 1 after the reaction of the analytes (see abstract), a computing unit 72 coupled to the scanner device 30b (see Figure 2) for receiving and analyzing the test signal, a controller device 76 coupled to the scanner device 30b, said scanning analyzer unit for accurately measuring, analyzing and testing biological samples. However Suzuki does not explicitly disclose that the computing unit outputs a control signal which is directed at a controller device, and said controller device is coupled to a driver device for receiving a driver signal for driving the scanner device for accurately measuring concentrations of analytes in a sample under test.
- B. The examiner takes Official Notice that it is commonly known to one skilled in the art that a computing unit is used for controlling any desired external peripherals, and that (software and hardware) driver devices are used for driving any external components or devices. For example, Suzuki teaches the use of a LED driver 75 to drive the LED light source (see Figure 2).

C. In view of what is commonly known in the art, it would have been obvious to one of ordinary skills in the art to incorporate a computing unit that outputs a control signal which is directed at a controller device, and said controller device is coupled to a driver device for receiving a driver signal for driving the scanner device in an instrument for accurately measuring concentrations of analytes in a sample under test.

12. Claims 3, 12 and 13 rejected for the same reasons of rejection of claim 1, and because, the examiner takes Official Notice that it is commonly known to one skilled in the art that any detected signal, such as from the scanner device in the instant application, is amplified/buffered for providing a reliable and more accurate signal to other connected devices such as an A/D converter.

13. Claims 4 and 14 are rejected for the same reasons of rejection of claim 3, and because Suzuki teaches of using an A/D converter (see col.7, lines 51-55) to convert a signal to digital format and transferred to the computing unit 72.

14. Claims 5, 6, 9, 15 and 16 are rejected for the same reasons of rejection of claim 1, and because the examiner takes Official Notice that it is commonly known to one skilled in the art that the use of interface such as RS-232 interface, between a computing unit and any other device is well known to all skilled in the art. It should be noted that the applicant has used "standard" RS-232 interface to qualify the limitation, which is an indication that said interface is "prior art."

15. With regard to the measuring of chemical or biological sample claimed in claims 10 and 17, in view of Suzuki's teaching of one type of sample, it would have been obvious to one of

ordinary skills in the art at the time the invention was made to test any other type of sample due to the fact that the apparatus is not dedicated to measuring only one type of sample.

16. Applicant's amendment has necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

17. Several facts have been relied upon from the personal knowledge of the examiner about which the examiner took Official Notice. Applicant must reasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946); In re Fischer, 125 F.2d 725, 52 USPQ 473 (CCPA 1942). See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice). If applicant does not reasonably traverse the well-known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA

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1943). A reasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well known statement is made.

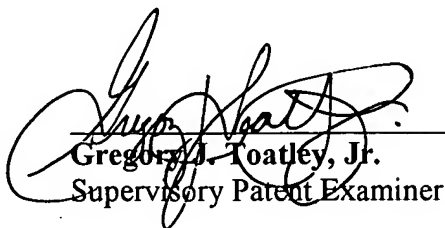
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**.

The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2800 ext.77**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Roy M. Punnoose
Patent Examiner
Art Unit 2877
April 18, 2005



Gregory J. Toatley, Jr.
Supervisory Patent Examiner